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EXAMINER

ROCHE, TRENTON J

ART UNIT PAPER NUMBER

2193

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/916,866

Applicant(s)

DAVIS ET AL.

Examiner

Trenton J. Roche

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-12 and 14-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12 and 14-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office action is responsive to communications filed 19 December 2005.
2. As per Applicants' request, amended claims 1, 8, 14, 22, 28 and 29 have been entered. Newly added claim 40 has been entered. Claims 1, 2, 4-12 and 14-40 are currently pending.
3. Claims 1, 2, 4-12 and 14-40 have been examined.

### *Double Patenting*

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 2, 4-12 and 14-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3 and 12 of U.S. Patent No. 6,282,712.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and issued patent claim the same subject matter of detecting a newly added computer to a data processing system ("determining when a new computer is added..." in claim 1 of the patent), automatically installing software on the new computer ("automatically

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installing the selected edition of the software onto the new computer..." in claim 1 of the patent), wherein the first and second computers are each have an associated natural language (claim 1 of the patent), wherein the first computer functions as a server ("the software installed on the new computer is a service of the centralized management system..." in claim 3 of the patent).

Furthermore, the patent discloses a detection component configured to detect the newly added computer by comparing a list of computers being managed to a previously generated list of computer ("detecting subsystem...comparing a stored list of the computer systems against a current list..." in claim 12 of the patent). While the patent does not explicitly disclose a heterogeneous system, it does disclose that the first computer has an associated natural language, and the second computer has an associated natural language. Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the methods disclosed in the patent in a heterogeneous data processing system, as this would allow easier integration with older legacy systems which operate on different natural languages.

### *Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 4-12, 14-34 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,286,041 to Collins, III et al. (hereinafter "Collins").

**Per claims 1, 8, 14, 22, 28 and 29:**

Collins discloses:

- a first computer configured to receive software, the first computer being newly added to the data processing system (Note at least Figure 1, item 2 and the corresponding sections of the disclosure. Further, "Not all computers are...connected to the internetwork at all times...When an Off-line Target...connects to the internetwork..." in col. 7 lines 18-33)
- a second computer configured to automatically determine when the first computer is newly added to the data processing system, the second computer being configured to automatically install the software onto the first computer in response to the second computer determining that the first computer is newly added to the data processing system such that the first computer functions as a server in a distributed processing system (Note at least Figure 1, item 1 and the corresponding sections of the disclosure. When the Off-line Target connects, software is downloaded to the Target. Finally, each Target sends values to another computer, as noted in Figure 7, consequently, according to the broadest reasonable interpretation, the Target is delivering information and acting as a server.)
- wherein the second computer is heterogeneous with respect to the first computer  
"heterogeneous set of computers..." in col. 8, lines 8-9)

substantially as claimed. Further, for specifics of claim 22 directed to stored preferences, note the discussion of criteria values in Figure 7 and column 8, lines 7-23.

**Per claims 2, and 4 - 7, incorporating the rejection of claim 1:**

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*"...wherein the software is a version of a program, and wherein the second computer includes a detection component for detecting when the version of the program is outdated and for installing a new version of the program onto the first computer."*

*"...wherein the first computer has an associated first natural language and wherein the second computer has an associated natural language."*

*"...wherein the first computer executes an operating system of a first type and wherein the second computer execute and operating system of a second type."*

Collins discloses a system for software distribution in a system with a heterogeneous set of computers having different hardware and software configurations. The limitations of claims 2-7 are inherent or at least implied in the disclosed system having the criteria-dependent feature disclosed at col. 8, lines 7 - 23.

**Per claim 9**, incorporating the rejection of claim 8:

*"...wherein the second computer is configured to start the software."*

See column 2, lines 48 - 57.

**Per claim 10**, incorporating the rejection of claim 8:

*"...wherein the first computer is associated with a first site and the second computer is associated with a second site."*

See Figure 1 and the corresponding sections of the disclosure.

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**Per claim 11**, incorporating the rejection of claim 10:

*“...wherein the second computer manages the second site.”*

See column 1, lines 40-54.

**Per claim 12**, incorporating the rejection of claim 8:

*“...wherein the second computer comprises a helper server, the helper server being configured to install the software on the first computer.”*

See column 5, lines 21 - 34.

**Per claim 15**, incorporating the rejection of claim 14:

*“...wherein the second computer is configured to start the software.”*

See column 2, lines 48 - 57.

**Per claim 16**, incorporating the rejection of claim 14:

*“...wherein the second computer comprises a helper server, the helper server being configured to install the software on the first computer.”*

See column 5, lines 21 - 34.

**Per claim 17**, incorporating the rejection of claim 14:

*“...wherein the second computer comprises a detection component configured to detect the first computer.”*

See column 7, lines 18-33.

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**Per claims 18-21**, incorporating the rejection of claim 14:

Note the rejections regarding claims 2 and 4-7.

**Per claims 23 and 24**, incorporating the rejection of claim 22:

*“...further comprising, automatically starting, by the second computer, the installed edition of the software on the first computer.”*

*“...further comprising delivering the edition of the software to a third computer, the third computer installing only the edition of the software onto the first computer directly from the third computer utilizing commands that are suitable for the operating system running on the first computer and based upon the stored preferences.”*

See column 2, lines 48-57 for automatically starting; and Figure 7 and column 8, lines 7-23 concerning criteria values to determine code suitable for a particular configuration.

**Per claim 25**, incorporating the rejection of claim 22:

*“...wherein determining when the first computer is added to the data processing system occurs periodically.”*

Scheduling is disclosed at column 2, lines 48-57; column 5, lines 24-27.

**Per claim 26**, incorporating the rejection of claim 22:

*“...wherein determining, when the first computer is added to the data processing system occurs in accordance with a predetermined amount of time set by an administrator of the data processing system.”*

Scheduling is disclosed at column 2, lines 48-57; column 5, lines 24-27.

**Per claim 27**, incorporating the rejection of claim 22:

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*“...wherein determining when the first computer is added to the data processing system occurs in accordance with an instruction of an administrator*

“Name of administrator scheduling transfer...” at column 5, line 14.

**Per claims 30-34**, incorporating the rejection of claim 29:

Note the rejections regarding claims 23-27, respectively.

**Per claim 40**, incorporating the rejection of claim 1:

*“...wherein the data processing system is the distributed data processing system and the first computer functions as a distributed server to increase the performance of the data processing system by having a service copied or moved from the second computer system to the first computer system.”*

Note that the software is distributed or copied from the Distribution Server to the Target.

Furthermore, the transmitted package “may contain a System Administration Command method...which performs some system administration function on the Target computer.” at column 6 lines 21-24. The method is an administration service.

### ***Allowable Subject Matter***

8. Claims 35-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicants' arguments concerning the rejection of claims 35-39 under 35 U.S.C. § 103(a) are considered persuasive. The rejection has been withdrawn. However, Applicants' arguments concerning claims 1, 2, 4-12 and 14-34 have been fully considered but they are not persuasive.

Applicants state that Collins does not disclose automatically determining when a first computer is newly added to a data processing system. In response, the rejection of claim 1 has been modified to more clearly outline the rejection. As is now indicated, Collins discloses the ability to recognize and detect that an Off-line Target has connected to the network, which then prompts a distribution of software to the Target. As such, Collins does disclose determining when a first computer is newly added to a data processing system. The rejection of claims 1, 2, 4-12 and 14-34 is proper and maintained.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. Patent 4,953,162, which discloses exchanging messages with a newly connected node on a network. See at least col. 6 lines 7-14.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trenton J. Roche whose telephone number is (571) 272-3733. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Trenton J Roche  
Examiner  
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TJR

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